

REMARKS

Status of the Claims and Support for New Claim 31 (37 C.F.R. § 1.173(c)):

Claims 1, 4-28, 30 and 31 are pending. Claims 2, 3 and 29 were previously canceled.

Regarding The Allowable Subject Matter:

Applicant notes with appreciation the allowance of claims 16-19 and 21.

Regarding the rejection based on 35 U.S.C. 251

The Examiner has reinstated the rejection of claims 1, 4-15, 20 and 22-28 under 35 U.S.C. 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based.

Applicant is somewhat confused by this position in light of the Examiner's position in the previous Office Action that his previous rejection of these claims was flawed and that claims 1 and 4-28 were in condition for allowance.

First, the Examiner contends that the removal of the language "sealing means surrounding the discharge end of a water passage formed in said nozzle housing; said sealing means including a seal member" in reissue claim 1 constitutes impermissible recapture since this language was added to the claims in an Amendment filed August 8, 1996. This is incorrect.

As discussed in Applicant's previously filed Appeal Brief, a patentee is not permitted to regain by way of a reissue claim which are broader or of the same scope as claims which were canceled or narrowed by amendment during prosecution of the original application, *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966); *In re Byers*, 230 F.2d 451, 456, 109 USPQ 53, 55-56 (CCPA 1956); *In re Wadsworth*, 107 F.2d 596, 599, 43 USPQ 460, 463 (CCPA 1939).

A very refined analysis is necessary to properly apply this rule. For example, in *Anderson v. International Engineering and Manufacturing, Inc.*, 160 F.3d 1345, 48 U.S.P.Q. 2d 1631 (Fed. Cir. 1998), the court stated that "a change of words does not always mean change of scope, and that

the question of whether the claims have been materially or substantially enlarged must be determined upon the claim as a whole, citing *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 27 USPQ2d 1521, (Fed. Cir. 1993). Also according to *Mentor, supra*, claims that are "broader than the original patent claims in a manner *directly pertinent to the subject matter surrendered* during prosecution" are impermissible. 998 F.2d at 996, 27 USPQ2d at 1525.

Moreover, the recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary, *In re Clement*, 131 F.3d 1464, 45 U.S.P.Q. 2d 1161.

As was explained in detail in Applicant's previously filed Appeal Brief, the reissue claims are not attempting to impermissibly broaden the limitations in question because (a) the amendments do not broaden the subject limitations, (b) the amendments are not directly pertinent to subject matter surrendered and/or (c) in any event, the portion of the added limitations amended were not added to overcome a prior art rejection.

The patent claim 1, prior to the present reissue application, recited a "sealing means" in a specific location (surrounding the discharge end of the water passage) and required that the sealing means include a "seal member" in that location. Reissue claim 1 of the present application still recites precisely the same structure in precisely the same location (i.e., a "seal surrounding the discharge end of the water passage ") as in the patent claim. The only changes are elimination of the word "member" in the recitation "seal member" and the phrase "sealing means surrounding the discharge end of the water passage formed in said nozzle housing, said sealing means including".

As originally filed, claim 1 called for providing "a sealed connection", and thus implicitly recited a seal. In conjunction with the other features added by the August 8, 1996 amendment, the seal was recited explicitly, but making explicit what was previously implicit does not narrow a claim. Claim 1 was narrowed by the recitation that the seal "... [surrounded] ... the discharge end of the water passage ...", as this specified the location of the seal in comparison to the location of the seal

in Balister. However, that limitation is still in reissue claim 1. Thus, claim 1 as presently pending is not broader in scope with respect to this feature.

Accordingly, it is respectfully submitted that the rejection should be withdrawn as to this aspect of claims 1 and 12.

The Examiner also argues that the removal of the language “means for retaining said nozzle selection sleeve in place” in presently pending reissue claim 1 also represents an impermissible recapture. This is also incorrect.

The Examiner has asserted that the limitation in question was added to claim 1 by the amendment of January 15, 1997 in response to a rejection. However, that the subject limitation could not have been added to claim 1 to distinguish it from the prior art. The January 15, 1997 amendment appears to have been the result of careless housekeeping.

In the Office Action dated October 29, 1996, claims 1 and 9 (*inter alia*) were rejected under 35 U.S.C. 102 as anticipated by the Saint-Raymond French patent 2,313,132. Claim 9 as originally presented, was dependent on claim 6, but that claim was canceled by the amendment dated August 8, 1996. Thus, claim 9 had no parent claim as of October 29, 1996.

This informality was noted and objected to by the Examiner in Section 1 of the October 29, 1997 Office Action, and applicant responded in the January 15, 1997 amendment by canceling claim 9, and incorporating the recitation of claim 9 (i.e., “means for retaining said rotatable sleeve in place”) into claim 1. In the Remarks, applicant argued that claim 1 was patentable over Saint-Raymond for several reasons, and these reasons were evidently persuasive, because the rejection was withdrawn, and the application was allowed. However, none of these reasons were related in any way to the means for retaining the portable sleeve in place. Whatever persuaded the Examiner to allow claim 1, it was most definitely not the inclusion of this limitation. For one thing, this limitation was never mentioned in applicant’s arguments. More importantly, however, this limitation does not distinguish the claim over the Saint-Raymond patent. Sleeve 32 in the reference has means for retaining it in place.

Finally, from the fact that both claims 1 and 9 were rejected as anticipated by Saint-Raymond, it is clear that the examiner himself did not consider that incorporating the limitation of claim 9 into claim 1 would make claim 1 allowable. In fact, as stated in Section 1 of the October

29, 1997 Office Action, the examiner “assumed for the purposes of [subsequently stated] rejections, that claim 9 was intended to be *dependent* on claim 1.

Realistically, there is no way to determine at this point why claim 9 was not simply made dependent on claim 1, as assumed by the examiner. Since something had to be done about the dependency of claim 9, perhaps it just seemed neater to combine the two claims because the limitation in question did not distinguish over the reference. That would be pure speculation, however, and it is certainly not reasonable to assume that the limitation was added to claim 1 to distinguish over the prior art when, in fact, it does **not do so**.

In any case, it is clear in retrospect, that adding the limitation was an error, and that applicant is entitled to correct this error by reissue. There is no reason for the Examiner to question applicant’s assertion that the error was without deceptive intention. Accordingly, it is respectfully submitted that the rejection should be withdrawn as to this aspect of claim 1.

Finally, the Examiner argues that the inclusion of claims 22-30 in the present reissue application which are allegedly broader in scope than patented claims 16-19 is also an example of impermissible recapture. This is incorrect.

As an initial matter, it is noted that claim 29 has been canceled herein, and thus, the rejection thereof is considered moot. Further, claim 30 has been amended to depend from claim 31, which has not been rejected under Section 251, and thus, the rejection of claim 30 under Section 251 should be withdrawn.

Applicant continues to be puzzled by this ground for rejection since it seems that present claim 22, which specifies that the nozzle can be changed while the sprinkler is operational, and previous claim 29, which broadly recites a nozzle plate, have been characterized as an attempted recapture simply *because* they are broader than claims 16-19 of the patent.

Claims 22 and 29 are broader than patent claim 16 (added to the original application as claim 23) in that the selectable nozzle arrangement of claim 22, and the nozzle plate of claim 29 are not required to be:

mounted over the outer surface of . . . [the sprinkler] . . . housing to rotate therewith and . . . [be] . . . manually rotatable relative to said housing . . .

It is respectfully submitted that claims 22-30 should be regarded as a legitimate attempt to secure broadened coverage of a combination for which protection was inadvertently (and without deceptive intention) not sought in the original application. As was previously explained, no claims of the scope of these claims were canceled from the original application, and no broader claims directed to this subject matter were ever narrowed in response to a rejection in the original application or during the re-examination.

The fact that more limited claims were *added* to the application does not preclude applicant from now seeking claims of broader scope. Since the combination of a rotatable sprinkler mounted on a riser, and having a nozzle plate is not shown in the prior art, failure to include claims of that scope in the original application, or to add them later, is clearly the kind of error which can legitimately be corrected by reissue and should not be regarded as an attempt to recapture subject matter abandoned to overcome prior art..

Since the Examiner has no basis for questioning applicant's declaration that these claims were omitted without deceptive intention, it is respectfully submitted that the rejection should be withdrawn as to claims 22-30.

Accordingly, it is respectfully submitted that the rejection of claims 1, 4-15, 20 and 22-28 under 35 U.S.C. 251 should be reconsidered and withdrawn.

Regarding the Prior Art Rejections:

In the outstanding Office Action, claims 30 and 31 stand rejected under 35 U.S.C. 102(b) as anticipated by Kah Jr. U.S. Patent 4,272,024 (Kah). Reconsideration and withdrawal of this rejection is respectfully requested in view of the amendments herein.

Kah is directed to a construction having a fixed nozzle plate which is riveted in place within the nozzle head. In contrast, the present invention discloses a construction in which the nozzle plate is adjustable. Indeed, claim 31 was added to the present application to emphasize these distinguishing features. As is specifically recited in claim 31, the nozzle plate is "movable relative to the nozzle housing to position the orifice in or out of alignment with the flow passage." As was explained in Applicant's previous Response, there is no disclosure, teaching or suggestion of this

in Kah. Indeed, the Examiner does not even appear to address this distinction at all in the Office Action and makes no mention of where this feature is described in Kah, Jr.

Accordingly, it is respectfully submitted that claim 31, and the claims depending therefrom, including claim 30, are patentable over the cited art for at least the reasons described above.

In view of the foregoing, favorable reconsideration and allowance of this application are respectfully solicited.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on November 19, 2008:

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Name of applicant, assignee or
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Signature

November 19, 2008

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